

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS LUCA CONTE

Appeal No. 2006-0635
Application No. 10/643,288

ON BRIEF

Before McQUADE, CRAWFORD, and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Francis Luca Conte, acting pro se, appeals from the final rejection of claims 1-20, all of the claims pending in the application.

THE INVENTION

The invention relates to an insect swatter that employs an elastic lash to perform the swatting function. Representative claims 1 and 17 read as follows:

1. An insect swatter comprising:
an elongate rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect; and
an elastic lash including a pair of annular rubber bands joined together at a knot therebetween, and having a proximal end

fixedly joined to said rod distal end, and an opposite distal end sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for swatting said lash distal end against said insect.

17. An insect swatter comprising:
an elongate rod having a slot at a distal end thereof;
an elastic lash configured in a figure eight with first and second knot-less loops at opposite ends, and joined together at a knot therebetween; and
said lash first loop is retained in said slot.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Kopp	1,009,531	Nov. 21, 1911
Stone	2,505,591	Apr. 25, 1950
Watkins	2,642,057	Jun. 16, 1953

THE REJECTIONS

Claims 1-4 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kopp.

Claims 5-9 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kopp in view of Watkins.

Claims 10-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kopp in view of Watkins and Stone.

Attention is directed to the main and reply briefs (filed May 5, 2005 and August 17, 2005) and the final rejection and answer (mailed December 17, 2004 and July 27, 2005) for the respective positions of the appellant and examiner regarding the merits of these rejections.¹

DISCUSSION

Kopp, the examiner's primary reference, discloses a toy gun for targeting flies or other insects. The gun comprises a handle portion 1, an elongated stock 2 extending forward from the handle portion, a resilient band 5 fastened at one end to the front of the stock by a pin or staple 4, a fixed piece 7 mounted at the back of the stock for releasably engaging the free end of the resilient band, and a resilient trigger 9 having one end portion 10 secured to the bottom of the stock, an intermediate portion 12 extending upwardly through an opening 3 in the stock and a second end portion 13 disposed adjacent the fixed piece. In use, one stretches the resilient band 5 and releasably engages its free end with the fixed piece 7, grasps the handle portion 1 with an

¹ In the final rejection, claim 17 also stood rejected under 35 U.S.C. § 112, first paragraph. Upon reconsideration, the examiner has withdrawn this rejection (see page 3 in the answer).

index finger on the trigger 9, points the gun at a fly or other insect (see Figure 1), and pulls the trigger causing its end portion 13 to disengage the resilient band from the fixed piece, whereby the free end of the band snaps forward of the gun to strike the target (see page 1, lines 59-74).

As conceded by the examiner (see page 3 in the final rejection), Kopp does not meet the limitation in independent claim 1 requiring the elastic lash to include a pair of annular rubber bands joined together at a knot therebetween, or the corresponding limitation in independent claim 17 requiring the lash to be configured in a figure eight with first and second knot-less loops at opposite ends joined together at a knot therebetween. The appellant's specification (see, for example paragraphs [0052-0071]) indicates that these features provide the lash with improved performance as compared with a simple rubber band lash. In contrast, Kopp's lash, resilient band 5, appears to be a flat strip.

The examiner deals with the admitted failure of Kopp to meet the lash limitations in claims 1 and 17 by submitting that:

Kopp shows one rubber band. However, given one rubber band, it would have been obvious to employ two for multiplied effect. See *In re Harza*, 124 USPQ 378. Further it would have been obvious to join the rubber bands

together to increase the range of the weapon [final rejection, page 3].

In response to the appellant's criticism of this line of reasoning, the examiner further contends that

The two rubber bands would be looped together with one end connected to means 4 and the other end would be connected to fixed piece 7 by a knot or other suitable connection. The motivation of using two rubber bands rather than one is merely that at some point in use the rubber band 5 is going to break, and when it does the user, may not have a rubber band of the same length as the original. The user might have two shorter rubber bands that add together in length to that of the original rubber band. So to keep the device operational the user would have the choice of waiting to get another rubber band of the same length as the original or employ two shorter rubber bands. Hence one skilled in the art would have found it obvious to employ two or a plurality of rubber bands instead of one. A user would have contemplated both a lengthwise connection between the rubber bands and also a side by side connection of the rubber bands along one stock. Other configurations are also possible. . . . The multiplied effect is that combination when connected in a U-shaped mounting with two ends mounted to the front of the rubber band gun and the middle portion mounted to the fixed piece 7 would have a wider area of rubber being sent at the insect which is a multiplied effect [answer, page 4].

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has

the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the rather imaginative rationale advanced by the examiner to account for the acknowledged deficiencies of Kopp vis-a-vis the lash limitations in claims 1 and 17 amounts to no more than unsupported conjecture. This evidentiary flaw finds no cure in the citation of In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) for the proposition that a mere duplication of parts has no patentable significance. To begin with, the inference of such a general or per se rule of obviousness from a case turning on specific facts has no basis in law. See In re Ochiai, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1995); In re Wright, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965). Furthermore, the application of such a per se rule to reject a claim constitutes legal error because it bypasses the particularized fact-specific inquiry required by § 103(a). Id. Finally, and in any event, the underlying description of the subject lash limitations in the appellant's specification belies any notion that they embody a mere duplication of parts.

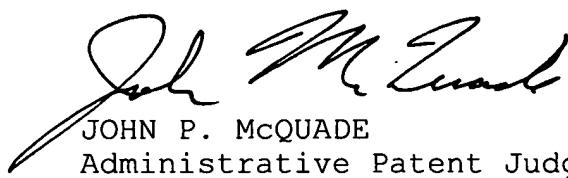
Thus, Kopp does not justify the examiner's conclusion that the differences between the subject matter recited in independent claims 1 and 17 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 17, and dependent claims 2-4, as being unpatentable over Kopp.

As the examiner's application of Watkins and/or Stone does not cure the shortcomings of Kopp relative to the subject matter recited in parent claims 1 and 17, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 5-9 and 18-20 as being unpatentable over Kopp in view of Watkins, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 10-16 as being unpatentable over Kopp in view of Watkins and Stone.

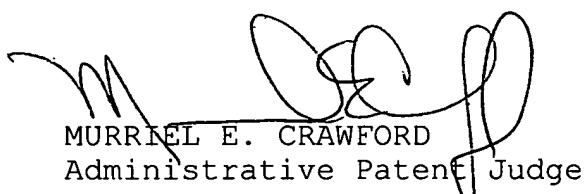
SUMMARY

The decision of the examiner to reject claims 1-20 is reversed.

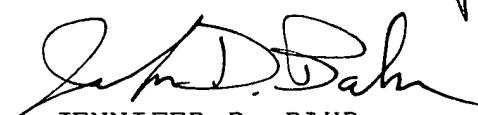
REVERSED



JOHN P. MCQUADE
Administrative Patent Judge



MURRIEL E. CRAWFORD
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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